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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,878	08/07/2003	Alejandro Wicchers	200207442-1	7671

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INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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MURPHY, DILLON J

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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07/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/630,878

Applicant(s)

WIECHERS, ALEJANDRO

Examiner

Dillon J. Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/7/03</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a method, program product, and system for managing workflow in a commercial printing environment, classified in class 358, subclass 1.15.
- II. Claim 10, drawn to an automated shipping device for use with a design-to-press workflow in a commercial printing environment, classified in class 705, subclass 406.

Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination Group II has separate utility such as automatically shipping packages in a distribution center, for example. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to

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provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

During a telephone conversation with Nathan Rieth on July 23, 2007 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claim 10 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 5 is drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP

2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claim 5, while defining a program product, does not define a "computer-readable medium" and is thus non-statutory for that reasons. A program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Specifically, the examiner recommends the following as an example of statutory claim language: "A computer readable medium encoded with a computer program..."

NOTE: Refer to Annex IV, section (a) of the USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility", Official Gazette notice of 22 November 2005 (currently at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>).

Claims 6-8 are inherently rejected under 35 U.S.C. 101 for depending on a rejected base claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al. (US 6,714,964) in view of Ferlitsch (US 2004/0070779).

Regarding claims 1, 5, and 9, Stewart teaches a method, program, and system for managing workflow in a commercial printing environment including a designer location and a print service provider location (Stewart, fig 2a and 2b, client 300a and backside 300b read on a designer location, and fig 2c, wherein printer side 300c reads on a print service provider location), said system comprising (Also see Stewart, col 4, ln 56-57, teaching a method and computer program):

Means for establishing a closed-loop communication link between the designer location and the print service provider location (Stewart, col 4, ln 56-61, establishing an Internet connection, and col 5, ln 17-30, system is connected via a communication link, wherein protocol over the Internet reads on a closed-loop communication link);

Means for creating a press ready file at the designer location using updated device configuration information (Stewart, fig 7b and col 4, ln 45-65, wherein a print ready file, which reads on a press ready file, is created by at the website co-location, which reads on creating files at the designer location. See col 7, ln 42-67, wherein information regarding the correct print driver to interface with the device is used to create a press ready file, which reads on using updated device configuration);

Means for submitting said press ready file to the print service provider location via said closed-loop communication link (Stewart, col 8, ln 45-col 9, ln 4, submitting the

press ready file to the print service, i.e. the print job is sent to a print queue, fig 7b #650 and fig 7c, #655); and

Means for receiving a printed output of said press ready file and shipping said printed output using an automated shipping device (Stewart, col 8, ln 45-col 9, ln 4, receiving output of press ready file and shipping the output. In col 7, ln 25-33 a FedEx delivery company reads on an automated shipping device).

Although Stewart teaches creating a press ready file at the designer location using updated device configuration, Stewart does not disclose expressly a method, program, or system comprising means for creating a press ready file at the designer location using updated device configuration information received from the print service provider location via said closed-loop communication link;

However, Ferlitsch teaches a method, program and system comprising means for creating a press ready file at the designer location using updated device configuration information received from the print service provider location via said closed-loop communication link (Ferlitsch, paragraph 22, wherein print ready files are created at the designer location, which reads on creating a press ready file. In paragraph 23, prior to the creation of the press ready file, the printer monitor in the designer location initiates a discovery of the status of the printing devices. This discovery from the printing source directly reads on receiving updated service configuration information from the print service location via the network. Also see paragraph 24 wherein information is used to create files. See paragraph 40 for additional support that discovering printers receives information from printers; status

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information regarding printer is received, which comes from the printer either directly or indirectly via the network).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the method, program and system of Ferlitsch comprising means for using and receiving updated device configuration information from the print service provider with the method, program and system of Stewart comprising establishing communication, creating a press ready file, submitting said press ready file, and receiving a printed output. The motivation for doing so would have been to get the most accurate information directly from the source in order to determine and monitor the capabilities and the printing process throughout the processing of the print job (Ferlitsch, paragraph 2). Therefore, it would have been obvious to combine Ferlitsch with Stewart to obtain the invention as specified in claims 1, 5 and 9.

Claims 2, 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al. (US 6,714,964) in view of Ferlitsch (US 2004/0070779) and further in view of Bresnan et al. (US 5,873,073).

Regarding claims 2 and 6, which depend from claims 1 and 5, respectively, the combination of Stewart and Ferlitsch teaches a method and program of managing a workflow in a commercial printing environment including a designer location and a print service provider comprising establishing a communication link, creating a press ready file, submitting said press ready file to the print service provider, and receiving a printed output and shipping said printed output using an automated shipping device. The



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combination of Stewart and Ferlitsch does not disclose expressly a method or program wherein said automated shipping device is a Design to Ship enabled device and forms part of said closed-loop communication link. However, Bresnan teaches a method and program wherein said automated shipping device is a Design to Ship enabled device and forms part of said closed-loop communication link (Bresnan, fig 1, mailing machine #40 and col 3, ln 32-43, wherein a mailing machine on the network reads on an automated Design to Ship enabled device forming part of the closed-loop communication link).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the method and program of Bresnan comprising an automated Design to Ship enabled device forming part of the communication link with the method and program of the combination of Stewart and Ferlitsch comprising managing a workflow in a commercial printing environment including a designer location and a print service provider comprising establishing a communication link, creating a press ready file, submitting said press ready file to the print service provider, and receiving a printed output and shipping said printed output using an automated shipping device. The motivation for doing so would have been to efficiently send output to a user requesting the print job. The suggestion for doing so was given by Stewart in fig 6 wherein the shipping department is integrated into the printing process for 300c. Therefore, it would have been obvious to combine Bresnan and the combination of Stewart and Ferlitsch to obtain the invention as specified in claims 2 and 6, respectively.

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Regarding claims 3 and 7, which depend from claims 2 and 6, respectively, the combination of Stewart, Ferlitsch and Bresnan teaches a method and program of managing a workflow wherein said automated shipping device is assigned a unique identifier (Bresnan, col 18, ln 55- col 19, ln 12, wherein a mailing machine connected to an input/output card via an interface cable reads on an assigned unique identifier. The mailing machine requires an identifier in order to be identified as the proper device).

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al. (US 6,714,964) in view of Ferlitsch (US 2004/0070779) and further in view of Bresnan et al. (US 5,873,073) and further in view of Hansen et al. (US 6,407,820).

Regarding claims 4 and 8, which depend from claims 2 and 6, respectively, the combination of Stewart, Ferlitsch and Bresnan teaches a method and program of managing a workflow in a commercial printing environment including a designer location and a print service provider comprising establishing a communication link, creating a press ready file, submitting said press ready file to the print service provider, and receiving a printed output and shipping said printed output using an automated shipping device, wherein the automated shipping device is a Design to Ship enabled device forming part of the communication link. The Stewart reference additionally teaches a method and program wherein after said step of submitting, said method further comprises a step of verifying, at said print service provider location, that said press ready file will be produced at said print service provider location as designed at the designer location (Stewart, fig 7, step 655, wherein a printer operator can select the job

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and queue it to an available printer. This reads on a verification step because the acceptance of the job shows it is verified).

The combination of Stewart, Ferlitsch and Bresnan does not disclose expressly if the file is not verified, correcting said press ready file to ensure production substantially as designed. However, Hansen teaches a method and program wherein if the file is not verified, the method and program comprise correcting said press ready file to ensure production substantially as designed (Hansen, col 19, ln 8-25, wherein if there is a problem with the print ready file, col 5, ln 47-53, there may be manual or automatic corrections to ensure production substantially as designed. Correcting occurs in the resource allocator in the print server, col 18, ln 58-66, which reads correcting at the print service provider location).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the correcting step of Hansen with the a method and program of managing a workflow in a commercial printing environment of Stewart, Ferlitsch and Bresnan including a designer location and a print service provider comprising establishing a communication link, creating a press ready file, submitting said press ready file to the print service provider, and receiving a printed output and shipping said printed output using an automated shipping device, wherein the automated shipping device is a Design to Ship enabled device forming part of the communication link, and verifying the press ready file will be produced. The motivation for doing so would have been to determine print job attributes and to match them with an appropriate output resource or correct the attribute in order to produce a particular page (Hansen, col 19, ln

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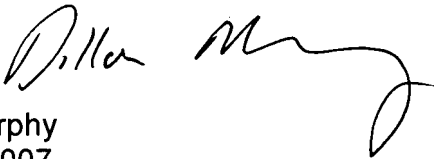
2-7). Therefore, it would have been obvious to combine Hansen with the combination of Stewart, Ferlitsch and Bresnan to obtain the invention as specified in claims 4 and 8.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon J. Murphy whose telephone number is (571) 272-5945. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Dillon Murphy  
July 23, 2007

  
AUNG S. MOE  
SUPERVISORY PATENT EXAMINER  
7/26/07